

REMARKS

The Office Action mailed January 25, 2008 has been received and reviewed. Claims 1-14 and 17-62 are in the case. Claims 1, 22, 39-41, and 62 stand rejected under 35 U.S.C. § 102(b). Claims 1-14 and 17-62 stand rejected under 35 U.S.C. § 103(a).

By this paper, claims 1, 61, and 62 have been amended. For the reasons set forth below, claims 1-14 and 17-62 are believed to be in condition for immediate allowance. Favorable reconsideration of the application in view of the following remarks is, therefore, respectfully requested.

Rejection of Claims 1, 22, 39-41, 61, and 62 Under 35 U.S.C. §102(b)

Claims 1, 22, 39-41, 61, and 62 stand rejected under 35 U.S.C. §102(b) as being anticipated by Shills. However, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." See MPEP §2131. With respect to the newly amended claims, Applicant does not find each and every claim element in Shills. Accordingly, Applicant asserts that the anticipation rejection based on Shills should be withdrawn.

For example, Applicant's claims require a distribution of globules or medallions that varies substantially randomly in lateral width along the longitudinal direction. Applicant does not find in Shills any disclosure of a distribution so configured. Rather, Applicant finds skills to teach against such a structure. For example, the widths of Shills' spray patterns 96, 98, 102 are, and must be, substantially constant. Applicant further finds that the those widths are determined by the widths of Shills' corresponding scrapers 66, which cannot be random.

For example, Shills discloses that "[t]he base coat applicator 50 has a configuration like that of the first overspray applicator 52 ... with the exception that the scraper 66 thereof is wide

enough to extend across the entire lengths of the drum 62 and the brush 64.” See Shills at col. 7, lns. 35-39. Accordingly, the spray pattern 96 of the base coat applicator 50 “extends across the entire width of each of the passing tiles” thereby coating “essentially the entire top surface 74 of each passing tile 10.” See Shills at col. 7, lns. 41-46. In contrast, “the overspray applicator 52 has a scraper 66 the length of which is substantially less than the lengths of the drum 62 and brush 64” to create a spray pattern 98 that has “a width less than that of the tiles 10.” See Shills at col. 7, lns. 50-56.

While the lateral location of Shills’ spray patterns 96, 98, 102 may vary, the widths of those spray patterns 96, 98, 102 are, and must be, substantially constant. Thus, Applicant asserts that Shills fails to disclose, and indeed teaches against, Applicant’s distribution that varies substantially randomly in lateral width along the longitudinal direction. Shills cannot, therefore, anticipate Applicant’s newly amended claims.

Additionally, with respect to claims 61 and 62, Applicant requires that the medallions be applied substantially exclusively to the exposed portion of the tiles. Applicant finds no such disclosure in Shills. In contrast, Applicant finds that Shills discloses, and Shills’ process and structures necessarily require, the application of a base coat to essentially the entire top surface 74 of each passing tile 10.”

Also, Applicant does not find disclosed in Shills any control or mechanism monitoring what portion of a tile is below the applicators 50, 52, 54. Accordingly, Applicant finds that Shills’ device has no way, and teaches against, any apparatus and method to limit application of the medallions to only the portion of the tiles that will be exposed.

This distinction is meaningful. Applicant finds that the droplets of slurry slung onto the tiles 10 by Shills’ applicators 50, 52, 54 are very small (effectively a point spray) and extend

from the tiles 10 a short, uniform distance. Accordingly, the layers of specks can be overlapped by other tiles without ill effects. In contrast, Applicant's recited medallions may be much larger and extend from the surface of the tiles or substrates much higher. However, because the medallions are located on the exposed portions of the tiles, the overlapping tiles can still be seated properly.

Furthermore, with respect to claim 62, Applicant requires throwing the globules by hand onto the tiles or substrates. Applicant finds no such disclosure in Shills. In contrast, Applicant finds that Shills teaches applicators 50, 52, 54 that are, and must be, fully automated to operate as disclosed. The painting effect taught by Shills would be impossible to produce with hand thrown globules.

Moreover, with respect to claim 62, Applicant requires molding the tiles in an uncured cementitious material and then forming medallions that directly contact the uncured cementitious material. Applicant finds no such disclosure in Shills. In contrast, Applicant finds that the first and second overspray layers are applied over a base coat covering "essentially the entire top surface 74 of each passing tile 10." See Shills at col. 7, lns. 41-46. Thus, Applicant finds Shills to teach against any medallion accents being applied to directly contact the material from which the tiles 10 of Shills are formed.

In view of the foregoing, Applicant asserts that Shills fails to anticipate, and indeed teaches against, Applicant's newly amended claims. Reconsideration is respectfully requested.

Rejection of Claims 1, 22, 39-41, 61 and 62 Under 35 U.S.C. §103(a)

Claims 1, 22, 39-41, 61 and 62 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Shills. However, to establish a *prima facie* case of obviousness, the Office

action must provide clear articulation of the reason(s) why the claimed invention would have been obvious. *See* MPEP 2143. Applicant asserts that Shills does not meet this test.

Shills does not teach or suggest all of the limitations of Applicant's newly amended claims. As set forth hereinabove, Applicant does not find in Shills any teaching or suggestion of a distribution of globules or medallions that varies substantially randomly in lateral width along the longitudinal direction. Applicant asserts that the applicators 50, 52, 54 of Shills teach against Applicant's claimed invention. The apparatus and method of Shills would have to be destroyed in structure and function, and then completely re-engineered to new structures and functions before they would be able to deliver distributions with random widths. Such re-engineering would certainly change the principle of operation of Shills and cannot therefore be an obvious modification. *See* MPEP §2143.01(VI). Furthermore, the Office Action is silent on this issue. Accordingly, the Office Action does not provide the required clear articulation of why the claimed invention would have been obvious.

Furthermore, with respect to claims 61 and 62, Shills does not teach or suggest applying the medallions substantially exclusively to the exposed portions of the tiles. Applicant asserts that the control routines disclosed in Figure 7 of Shills teach thereagainst. Shills system would have to be effectively destroyed and completely re-engineered to a new purpose before Shills' applicator 50, 52, 54 could limit the various coats to an exposed portion.

Again, the Office Action is silent on this issue. Accordingly, the Office Action does not provide the required clear articulation of why the claimed invention would have been obvious.

Moreover, with respect to claim 62, Shills does not teach or suggest throwing by hand a substantially random distribution of globules. Also, Applicant asserts that Shills' even and uniform base coats generated by the continuous flipping of droplets by the mechanisms of Shills

could not be duplicated by hand throwing. The Office Action is silent on this issue.

Accordingly, the Office Action does not provide the required clear articulation of why the claimed invention would have been obvious.

In view of the foregoing, Applicant asserts that the Office Action does not provide a clear articulation of why the newly amended claimed would have been obvious. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the claim rejections.

Rejection of Claims 2 and 44-53 Under 35 U.S.C. §103(a)

Claims 2 and 44-53 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Shills in view of Maurer. However, to establish a *prima facie* case of obviousness, the Office action must provide clear articulation of the reason(s) why the claimed invention would have been obvious. See MPEP 2143. With respect to the newly amended claims, the combination of Shills and Maurer does not meet this test.

As set forth hereinabove, Shills does not teach or suggest all of the limitations of Applicant's newly amended claims. Adding the teachings of Maurer to those of Shills does not remedy the deficiencies noted. Accordingly, the Office Action does not provide the required clear articulation of why the claimed invention would have been obvious.

Additionally, the Office Action asserts that Maurer teaches a synthetic roofing member capable of being brushed to provide texturing. However, this is not accurate. Applicant finds that Maurer teaches brushing such as that done on natural slate to highlight the patterns on the already formed (and hardened) members 10. See Maurer at col. 3, ln. 66 through col. 4, ln. 3. Thus, the brushing taught by Maurer is polishing, not texturing. Polishing is the opposite of texturing. Accordingly, the Office Action has not provided the required clear articulation of why

the claimed invention would have been obvious. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the claim rejections.

Rejection of Claims 5-14, 17-21, 23-29, 31-43, and 54-60 Under 35 U.S.C. §103(a)

Claims 5-14, 17-21, 23-29, 31-43, and 54-60 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Shills in view of De Paoli. However, to establish a *prima facie* case of obviousness, the Office action must provide clear articulation of the reason(s) why the claimed invention would have been obvious. See MPEP 2143. With respect to Applicant's newly amended claims, the combination of Shills and De Paoli does not meet this test.

As set forth hereinabove, Shills does not teach or suggest all of the limitations of Applicant's newly amended claims. Adding the teachings of De Paoli to those of Shills does not remedy the deficiencies noted. Accordingly, the Office Action does not provide the required clear articulation of why the claimed invention would have been obvious.

Additionally, the Office Action states that it would have been obvious to incorporate the method of De Paoli into that of Shills. Applicant respectfully asserts that this statement is improper. The method of De Paoli is incompatible with that of Shills. De Paoli teaches a method wherein a slab of terrazzo with stone chips up to two inches in size is poured, then preformed spatters are inserted by hand. The result is then cured and ground smooth. See De Paoli at col. 1, lns. 30-36 and col. 1, ln. 62 through col. 2, ln. 29. This process bears no resemblance to the method of Shills.

Furthermore, the applicators 50, 52, 54 of Shills would have to be replaced with a structure re-engineered to a different purpose to ever insert spatters as taught by De Paoli. Thus, the Office Action does not provide the required clear articulation of why the claimed invention

would have been obvious. Moreover, the proposed modification or combination of the prior art would impermissibly change the principle of operation of Shills. *See* MPEP §2143.01(VI).

Furthermore, the Office Action asserts that De Paoli teaches medallions that would inherently simulate the appearance of biota. However, Applicant finds that De Paoli teaches terrazzo that is "ground smooth" with a "fine finished condition." *See* De Paoli at col. 2, ln. 17 and col. 3, lns. 7-10. Applicant finds nothing in such a surface, that has ground stones and binders smooth and exposed to form a fine finish, to ever simulate the appearance of biota. Again, the Office Action does not provide the required clear articulation of why the claimed invention would have been obvious.

In view of the foregoing, reconsideration is respectfully requested.

Rejection of Claims 3, 4, and 30 Under 35 U.S.C. §103(a)

Claims 3, 4, and 30 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Shills in view of Arpin. However, to establish a *prima facie* case of obviousness, the Office action must provide clear articulation of the reason(s) why the claimed invention would have been obvious. *See* MPEP 2143. With respect to Applicant's newly amended claims, the combination of Shills and Arpin does not meet this test.

As set forth hereinabove, Shills does not teach or suggest all of the limitations of Applicant's newly amended claims. Adding the teachings of De Paoli to those of Shills does not remedy the deficiencies noted. Accordingly, the Office Action does not provide the required clear articulation of why the claimed invention would have been obvious.

Additionally, it is improper to combine references where the references teach away from their combination. *See* MPEP §2145(X)(D)(2). In this case, Shills expressly teaches the use of a

"slurry." A slurry is "a watery mixture of insoluble matter." See www.merriam-webster.com (emphasis added). Thus, it is improper for the Office Action to force the use of "the driest consistency possible," as assertedly taught by Arpin, on Shills.

In view of the foregoing, reconsideration is respectfully requested.

Rejection of Claim 53 Under 35 U.S.C. §103(a)

Claim 53 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Shills in view of Maurer and Maletic. However, to establish a *prima facie* case of obviousness, the Office action must provide clear articulation of the reason(s) why the claimed invention would have been obvious. See MPEP 2143. With respect to Applicant's newly amended claims, the combination of Shills, Maurer, and Maletic does not meet this test.

As set forth hereinabove, Shills does not teach or suggest all of the limitations of Applicant's newly amended claims. Adding the teachings of Maurer and Maletic does not remedy the deficiencies noted. Accordingly, the Office Action does not provide the required clear articulation of why the claimed invention would have been obvious.

Additionally, Applicant does not find in the combination of Shills, Maurer, and Maletic any teaching or suggestion of texturing the top surface of a substrate in a pattern with a random orientation. In contrast, Applicant finds that Maletic teaches a very regular texturing pattern with a regular orientation. The Office Action is silent on this issue and provides no citation to any teaching of a random orientation. Accordingly, the Office Action does not provide the required clear articulation of why the claimed invention would have been obvious.

In view of the foregoing, reconsideration is respectfully requested.

Rejection of Claims 12, 17-20, and 54-60 Under 35 U.S.C. §103(a)

Claims 12, 17-20, and 54-60 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Shills in view of Gundlach and Chaffee. However, to establish a *prima facie* case of obviousness, the Office action must provide clear articulation of the reason(s) why the claimed invention would have been obvious. *See* MPEP 2143. With respect to Applicant's newly amended claims, the combination of Shills, Gundlach, and Chaffee does not meet this test.

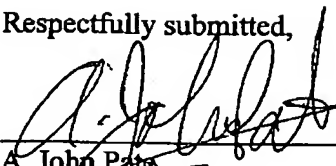
As set forth hereinabove, Shills does not teach or suggest all of the limitations of Applicant's newly amended claims. Adding the teachings of Gundlach and Chaffee does not remedy the deficiencies noted. Moreover, the Office provides a citation and asserts that Chaffee teaches providing cementitious roofing tiles with a green coloring. However, after reviewing the location cited, Applicant finds nothing teaching or suggesting the color green. Accordingly, the Office Action does not provide the required clear articulation of why the claimed invention would have been obvious.

In view of the foregoing, reconsideration is respectfully requested.

In the event that the examiner finds any remaining impediment to the prompt allowance of any of these claims, which could be clarified in a telephone conference, the examiner is respectfully urged to initiate the same with the undersigned.

DATED this 11th day of June, 2008.

Respectfully submitted,



A. John Pata
Reg. No. 36,234
Attorney for Applicant

Date: June 11, 2008

PATE PIERCE & BAIRD
175 South Main Street, Suite 1250
Salt Lake City, Utah 84111
Telephone: (801) 530-0330
Facsimile: (801) 530-5955

2553-2-3 PAT-FIL-ROA3.wpd